

DETAILED ACTION

1. This application is a RCE of SN 10/751,584.

Claims 2, 14-23 have been canceled. Claims 24, 28-35 stayed withdrawn from consideration. Claims 1, 3-13, 25-27, 36 and newly added 37-38 are pending.

2. *Examiner's Amendment*

Authorization for this examiner's amendment was given in a telephone interview with Kurt G. Briscoe on Dec. 15, 2008.

Claims **13**, last line, the term "physiologically acceptable auxiliary substances." is deleted. In its place insert

--matrix materials, fillers, solvents, diluents, surface-active substances, dyes, preservatives, suspending agents, slip agents, lubricants, aromas and binders.—

Claims **24, 28-35** are canceled.

3. *Reason for Allowance*

The following is an examiner's statement of reasons for allowance:

The closest prior art of record is Cuny et al. US 6,677,332. Cuny et al. disclosed 3-substituted phenylethylpiperidines which are opiate receptor binding compounds (see col. 113-114). The instant claims are position isomers (4-substituted phenylethylpiperidines) of the Cuny et al '332 compounds (3-substituted phenylethyl piperidines). Yamamoto '247 disclosed 4-substituted phenylethylpiperidines having utility of treating pain. Newly available references by Yamamoto et al. US 6,956,046 and Akada et al. evidenced that for the 4-substituted phenylethyl piperidine to have activity for treating pain, a 4,4-gem disubstitution is required. In addition, the Yamamoto '046 compounds are sodium channel binding compounds. Therefore, one having ordinary skill in the art lacks motivation in combining two different receptor active compounds with further modification in eliminating a gem substituents to arrive at the instantly claimed compounds or any expectation that such modification would render active compounds. Claims 1, 3-13, 25-27, 36-38 as currently amended, devoid of gem substitution, are neither anticipated nor rendered obvious by the art of record.

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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang, Ph. D. whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet L. Andres, Ph. D., can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
Dec. 15, 2008

/Celia Chang/
Primary Examiner
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